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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SERGEY MATASOV

Appeal 2010-010580
Application 09/509,377
Technology Center 3700

Before DONALD E. ADAMS, FRANCISCO C. PRATS, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 involving claims to an
endoscope. We have jurisdiction under 35 U.S.C. § 6(b). We affirm.

Statement of the Case

The Claims

Claims 1, 4, 5, 10, 11-13, 15, 17, 18, 21, and 22 are on appeal. Claims 1 and 11 are representative and reads as follows:

1. An endoscope with disposable cartridges for the invagination of endoscopic tube, comprising
an endoscopic tube (3) having a distal part with a guided distal end,
a disposable cartridge located on the distal part of the endoscopic tube (3) and comprising an invaginator of the endoscopic tube, which invaginator is an eversible tube with an uneverted end (7) joined with the endoscopic tube (3), and, an uneverted part of invaginator formed by pleats into a compact hollow cylinder (23), having a gap (25) with the distal part of the endoscopic tube (3).

11. The endoscope according to [claim 1, wherein the cylinder (23) of the invaginator comprises narrowings (24) of its external diameter and widenings (24) of its internal diameter,] wherein the tip (6) comprises a protective glass (33).

The issues

- A. The Examiner rejected claims 11-13, 15, 17, 18, and 22 under 35 U.S.C. § 112, second paragraph as indefinite (Ans. 4-5).
- B. The Examiner rejected claims 1, 4, 5, 10, 11, 21, and 22 under 35 U.S.C. § 102(d) as anticipated by Matasov¹ (Ans. 5-6).
- C. The Examiner rejected claim 13 under 35 U.S.C. § 103(a) as obvious over Matasov and Avitall² (Ans. 6).

¹ Matasov, SU 1522466 A1, published July 1989.

² Avitall, Boaz, US 5,441,483, issued Aug. 15, 1995.

D. The Examiner rejected claim 15 under 35 U.S.C. § 103(a) as obvious over Matasov and Wilk³ (Ans. 7).

A. *35 U.S.C. § 112, second paragraph*

We will summarily affirm the Examiner's indefiniteness rejection. Appellant does not contend that the rejection is incorrect, or should otherwise be withdrawn (*see* App. Br. 3). Instead, Appellant states that there "is enclosed also (see Enclosure 1) the clean copy of the claims, where the references in claims 11-13, 15, 17, 18 and 22 are corrected in accordance with the observations of examiner" (App. Br. 3). Appellant thus concedes, in effect, that the claims actually rejected by the Examiner are in fact indefinite.

B. *35 U.S.C. § 102(d) over Matasov*

The Examiner finds that "Matasov discloses an endoscopic tube (3) with a distal part/guided distal end (part of tube 3 in the vicinity of tip 6) comprising a disposable cartridge (4) located on the distal part of the endoscopic tube and formed of a compact hollow cylinder (7) gathered by pleats . . . with an unverted end (proximal, pleated end 7) which is coupled with and held on the distal part of the tube" (Ans. 5).

The Examiner finds that "[i]nherently, because they are separate elements, there is a gap between the cylinder (7) and the endoscopic tube (3)" (Ans. 6).

Appellant contends that the "error in the rejection are examiner's allegations that SU 1522466 discloses the 'cartridge (4) ... formed of a compact cylinder (7)' and that 'Inherently there is a gap between the

³ Wilk et al., US 5,396,879, issued Mar. 14, 1995.

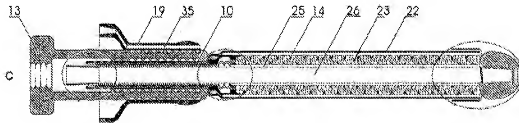
cylinder and the endoscopic tube’, as there is no arguments in favour of these allegations” (App. Br. 3).

Appellant contends that “[o]ne can see evidently from above, that invaginator according to the present application formed in a compact hollow cylinder which has the gap with the endoscopic tube, is not the subject matter of SU 1522466” (App. Br. 5).

In view of these conflicting positions, we frame the anticipation issue before us as follows: Does the evidence of record support the Examiner’s conclusion that Matasov anticipates claim 1?

Findings of Fact

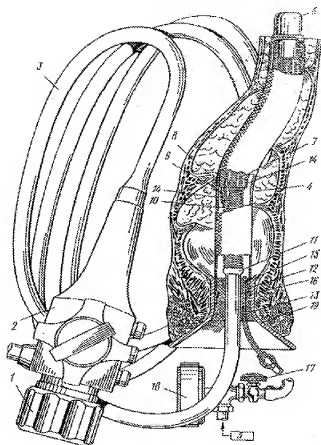
1. Figure 1c of the Specification is reproduced below:



“[F]ig. 1 is represented the endoscope with disposable cartridge for invagination, where: . . . c - longitudinal section of cartridge” (Spec. 4).

2. The Specification teaches that “[i]nvaginator 23 has narrowings and widenings 24, as well as gap 25 with distal condom 26” (Spec. 5).
3. The Specification teaches “25 - gap (cavity) between cylinder of invaginator 23 and condom 26” (Spec. 7).

4. Figure 1 of Matasov is reproduced below



“On the drawing there is presented the general view of intestinal endoscope”
(Matasov, col. 3, ll. 7-8).

5. Matasov teaches that the “endoscope has the device for propulsion of light pipe 3 inside the examined cavity, which includes the thin-walled elastic tube 4 and the source 5 of excess pressure, but on the working end of light pipe 3 the projection 6 is made” (Matasov, col. 3, ll. 13-18).

6. Matasov teaches that the “end 7 of the tube 4 is movably fixed on the light pipe 3 with the help of rings 8 and 9, is executed as pleated and

is spring-loaded by spring 10, which one is rested on the projection 11 of the light pipe 3” (Matasov, col. 3, ll. 18-24).

7. Matasov teaches that the “other end 12 of the tube 4 with the help of seal 13 is also movably placed on the light pipe 3 and everted, thus forming the closed cavity 14 between the parts of tube 4, connected through airway 15 with the source 5 of excess pressure” (Matasov, col. 3, ll. 25-30).

8. Matasov teaches that “with the beginning of insertion of flexible light pipe 3 under the action of air pressure there begins the eversion and the transition of pleated part of thin-walled elastic tube, gathered on the light pipe 3, into the everted part. Thus being everted and invaginated into the gastrointestinal tract, the everted part 12 of tube 4 under the air pressure action is trying to become straight” (Matasov, col. 4, ll. 15-24).

9. Matasov teaches that the “prevalence of rigidity of the longitudinal axis of the everted part 12 of the thin-walled elastic tube 4 over the rigidity of the light pipe 3 ensures its insertion into the filled with air cavity 14 and the realization of endoscopy of gastrointestinal tract” Matasov, col. 4, ll. 29-35).

Principles of Law

“A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference.” *In re Paulsen*, 30 F.3d 1475, 1478-79 (Fed. Cir. 1994); *see Karsten Manufacturing Corp. v. Cleveland Golf Co.*, 242 F.3d 1376, 1383 (Fed. Cir. 2001) (“Invalidity on the ground of ‘anticipation’ requires lack of novelty of the invention as claimed ... that is, all of the elements and

limitations of the claim must be shown in a single prior reference, arranged as in the claim.”).

Analysis

Matasov teaches an endoscope which comprises an endoscopic tube (FF 4). Matasov teaches an elastic tube, which is necessarily disposable, where “the eversion and transition of pleated part of thin-walled elastic tube, gathered on the light pipe 3, into the everted part. Thus being everted and invaginated into the gastrointestinal tract, the everted part 12 of tube 4 under the air pressure action is trying to become straight” (Matasov, col. 4, ll. 15-24; FF 8). Figure 1 of Matasov shows a cavity 14 between the light pipe 3 and the tube 4 (FF 4). Matasov teaches that the “prevalence of rigidity of the longitudinal axis of the everted part 12 of the thin-walled elastic tube 4 over the rigidity of the light pipe 3 ensures its insertion into the filled with air cavity 14 and the realization of endoscopy of gastrointestinal tract” Matasov, col. 4, ll. 29-35; FF 9).

Appellant contends that the “error in the rejection are examiner’s allegations that SU 1522466 discloses the ‘cartridge (4) ... formed of a compact cylinder (7)’ and that ‘Inherently there is a gap between the cylinder and the endoscopic tube’, as there is no arguments in favour of these allegations” (App. Br. 3).

We are not persuaded. Matasov clearly teaches a cavity 14, which consistent with Appellant’s own Specification is a gap (FF 2-3). In addition, we agree with the Examiner that there is a gap between cylinder 7 and light tube 3, since these are separate elements which are not physically joined to one another. *See In re Best*, 562 F.2d 1252, 1254-55 (CCPA 1977) ([W]here

the Patent Office has reason to believe that a functional limitation asserted to be critical for establishing novelty in the claimed subject matter may, in fact, be an inherent characteristic of the prior art, it possesses the authority to require the applicant to prove that the subject matter shown to be in the prior art does not possess the characteristic relied on. ... Whether the rejection is based on “inherency” under 35 U.S.C. § 102, on “prima facie obviousness” under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.”) Appellant has presented no evidence to rebut this inherency argument.

Appellant contends that “[o]ne can see evidently from above, that invaginator according to the present application formed in a compact hollow cylinder which has the gap with the endoscopic tube, is not the subject matter of SU 1522466” (App. Br. 5).

We are not persuaded. The limitations identified by Appellant at (App. Br. 5) are either taught by Matasov or represent intended use recitations for this product claim. For example, the limitation of “crumpled and tightly compressed . . . short layers” is reasonably satisfied by the teaching in Matasov where “end 7 of the tube 4 is movably fixed on the light pipe 3 with the help of rings 8 and 9, is executed as pleated” (Matasov, col. 3, ll. 19-22; FF 6). The other limitations such as “is not gathering on the endoscopic tube, but is putting on it as a whole” (App. Br. 5) represent an intended use of the device, rather than a structural limitation on the device itself. An intended use that merely states the purpose of the claimed subject matter, without adding additional structure to it, is generally not treating as

limiting the scope of the claim. *See Boehringer Ingelheim Vetmedica, Inc. v. Schering-Plough Corp.*, 320 F.3d 1339, 1345 (Fed. Cir. 2003).

Conclusion of Law

The evidence of record supports the Examiner's conclusion that Matasov anticipates claim 1.

C. & D. 35 U.S.C. § 103(a)

Appellant relies on the argument that “[a]s above is well-proven that the invaginator formed in a compact hollow cylinder which has a gap with an endoscopic tube, is not the subject matter of SU 1522466, the dependent claims 13 and 15 could not be rejected under 35 U.S.C. § 103(a)” (App. Br. 6).

Since we conclude that Matasov teaches a gap for the reasons discussed above, and since Appellant provides no separate argument for the obviousness rejections, we will affirm the Examiner's obviousness rejections over claims 13 and 15 since we do not find the arguments over the 35 U.S.C. § 102 rejection over Matasov persuasive.

SUMMARY

In summary, we affirm the rejection of claims 11-13, 15, 17, 18, and 22 under 35 U.S.C. § 112, second paragraph as indefinite.

We affirm the rejection of claim 1 under 35 U.S.C. § 102(d) as anticipated by Matasov. Pursuant to 37 C.F.R. § 41.37(c)(1)(vii)(2006), we also affirm the rejection of claims 4, 5, 10, 11, 21, and 22, as these claims were not argued separately.

We affirm the rejection of claim 13 under 35 U.S.C. § 103(a) as obvious over Matasov and Avitall.

We affirm the rejection of claim 15 under 35 U.S.C. § 103(a) as obvious over Matasov and Wilk.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv)(2006).

AFFIRMED

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